

REMARKS

This is in full and timely response to the above-identified Office Action. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

Anticipation Rejections

- 1) The rejection of dependent claims 36 and 37 under 35 USC § 102(b) as being anticipated by each of Brunelle (Molecular Reports, 1991), Kashiwagi (JP 11-158261), Sakashita '817 or Sakashita '233, is moot.

This rejection hinges on the fact that claims 36 and 37 are product by process claims and therefore subject to a different standard of examination (MPEP 2113). The rejection is rendered moot by the cancellation of claims 36 and 37.

Obviousness Rejections

- 1) Claims 1-35 and 38-45 under 35 USC § 103(a) stand rejected as being unpatentable over Sakashita '233 in view of Willson '633.

This rejection is respectfully traversed. In this rejection, the Sakashita '233 reference which is applied against the product-by-process claims 36 and 37 is cited in this rejection as if it were a valid reference under 35 USC 102(b) for the claimed method.

However, the "product-by-process" anticipation rejection is based on the assumption that the product which results from the claimed process will be the same as that which results from a process disclosed in the reference, irrespective of the fact that the disclosed method is different. In this rejection, the claimed method steps are ignored and there is no showing that any of the claimed method steps are in fact disclosed or suggested in Sakashita '233.

Since the rejected claims are method claims, it is imperative that the reference which are cited disclose or reasonably suggest the claimed steps.

Inasmuch as the Sakashita '233 reference does not contain any such relevant disclosure, the rejection is respectfully traversed.

Further, in this rejection it is acknowledged that Sakashita '233 does not disclose/teach simultaneous testing of catalyst compositions on a substrate. To overcome this admitted shortcoming, Willson '633 is cited. The motivation cited for transferring teachings from Willson '633 to Sakashita '233 is that it would have been obvious because comparative analysis would be expected to save time and cost as per the teachings of Willson '633.

Applicant respectfully disagrees because Willson '633 discloses that it is the robotic implementation of the testing method (column 1, lines 37-40) rather than the method per se, that enables a sharp reduction in labor costs per catalyst screened. The robotic issue is not raised in connection with the cost based motivation.

The rejection is further traversed in that Sakashita '233 is directed to a polycarbonate having outstanding thermal resistance, outstanding color-matching properties and transparency, and, in particular, improved hardness, a copolycarbonate composition, and a method for its manufacture. Willson '633, on the other hand, is directed to the general field of catalyst testing.

It is submitted that without a working knowledge of the claimed subject matter there would be no possibility whatsoever of the hypothetical person of ordinary skill considering each of these references and then proceeding (without inventive effort) to the claimed subject matter.

That is to say, a *prima facie* case of obviousness can only be established if the hypothetical person of ordinary skill would, when proceeding with a total lack of knowledge of the claimed subject matter and without any inventive activity, be led by a) the teachings of the references when considered as a whole and b) that knowledge which is commonly known in the art to which the invention pertains, to

the claimed subject matter. If these criteria cannot be met, a *prima facie* case of obviousness cannot be established.

Sakashita '233 discloses the use of different catalysts. However, Sakashita '233 disclosure does not suggest that there is a need to conduct tests with respect to the catalysts. Accordingly, there is no need (motivation) for the hypothetical person of ordinary skill to look to Willson '633 for any teachings with respect to test procedures. Furthermore, there is no motivation to conduct the testing of the different materials of Sakashita '233 on the same substrate.

It is submitted that a *prima facie* case of obviousness cannot be built on this combination of references and as such the rejection is respectfully traversed.

- 2) Claims 1-35 and 38-45 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40 of USP 6,307,004 to Caranhan et al. (Caranhan) in view of Sakashita'233.

It is respectfully requested that this rejection be held in abeyance until such time as the allowability of the application is indicated and the exact scope of the claims is determined. At that time, the issue of filing a terminal disclaimer will be reconsidered.

Conclusion

It is respectfully submitted that the teachings of citations applied against the claimed subject matter are insufficient to enable a prima facie case of obviousness to be established. Favorable reconsideration of the claims and allowance of this application is courteously solicited.

Respectfully submitted,

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FOLEY & LARDNER
Customer Number: 22428

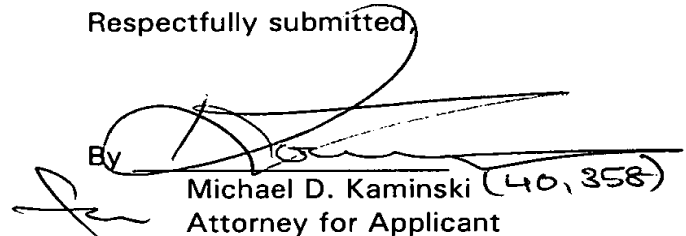


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PATENT TRADEMARK OFFICE

Telephone: (202) 672-5490

Facsimile: (202) 672-5399

By 
Michael D. Kaminski (40,358)
Attorney for Applicant
Registration No. 32,904